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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/825,431  
Filing Date: April 03, 2001  
Appellant(s): BAKER ET AL.

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Oleg Ioselevich  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04/02/10 appealing from the Office action mailed 06/02/09.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,092,201	TURNBULL et al.	07-2000
6,760,752 B1	LIU et al.	07-2004
2003/0196098	DICKINSON et al.	10-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 12, 17-18, 23, 25, 26, 49, 53, 56-59, and 71-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al., US 6,092,201, 07/18/00 (filed 01/27/98) in view of Liu et al. ("Liu"), U.S. Patent No. 6,760,752.**

Regarding claim 1, Turnbull discloses a system for extending secure communication operations which meets the limitation, ***a digital communication system to denote confidentiality of a digital communication***. See abstract and title.

Turnbull discloses using attribute certificates which convey access privileges or authorization for certain actions set by a user which meets the limitation, ***attach a privilege attribute to a digital communication, the privilege attribute selected by the creator of the digital communication before the digital communication is sent***. See abstract and column 4, lines 7-30.

Turnbull discloses creating a distribution list of recipients and associating the list with a secure communication which meets the limitation, ***create a privileged distribution list of at least one intended recipient and associate the privileged distribution list with the digital communication when the digital communication is created***. See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

Turnbull discloses the list of recipients is used to restrict access to the secure communication which meets the limitation, ***restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list***. See column 3, lines 14-51.

Turnbull discloses a system to extend secure communication **operations** which include accessing and routing of secure communications. A user not on the list of intended recipients will not be able to receive the digital communication which meets the limitation, ***restrict routing of the privileged digital communication to the intended***

***recipients and prevent forwarding of the digital communication to an unintended recipient.*** See columns 3-4 and column 6, lines 28-49.

Turnbull discloses a user selects a shared list of intended recipients before a message is sent which meets the limitation, ***wherein intended recipients are selected by the creator of the digital communication before the digital communication is sent.*** See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

Turnbull does not expressly teach ***store the privileged digital communication in a segregated location for privileged digital communications on a data storage device.***

However, Liu discloses ***storing the privileged digital communication in a segregated location for privileged communications on a data storage device*** (Liu teaches storing the communication on the key server which facilitates secure transfers of messages. Specifically, the key server refers to a computer that includes a server program for maintaining, validating, and providing keys for use by clients in transmitting secure emails (i.e. privileged digital communications) and other messages over a network. The key server. See figure 1, figure 2B, 258 where a message is transmitted to a key server. See also column 3, lines 12-16, column 10, lines 31-36, and column 13, lines 3-11

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Turnbull with the teachings of Liu to store the communication at a segregated location specifically for privileged digital communications because both references are from the same field of endeavor of

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providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claim 2**, Turnbull discloses a distribution list of recipients which can comprise multiple intended recipients which meets the limitation, ***the at least one intended recipient is a plurality of intended recipients***. See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

**Independent claim 18** incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

**With respect to independent claims 49, 71 and 72**, please refer to the rationale relied upon to reject independent claim 1, which contains substantially similar subject matter, as discussed above.

**Claims 17, 25, 26, and 53** incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

**Claims 57 and 58** incorporate substantially similar subject matter as independent claim 18 and are rejected along the same rationale.

**Regarding claims 12, 23, 56, and 59**, Turnbull teaches the secure communication is encrypted. See columns 3-5.

**Claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al., US 6,092,201, 07/18/00 (filed 01/27/98) in view of Liu et al. (“Liu”), U.S. Patent No. 6,760,752 and further in view of Dickinson, III et al. (“Dickinson”), U.S. Patent Application Publication No. 2003/0196098.**

**Regarding claim 3**, Turnbull discloses *a mail server*. See column 3, lines 51-67 and column 4. Turnbull does not disclose a segregated server housing the segregated location for the privileged communication or a program executable to send a copy of the communication to the segregated server.

However, Liu discloses a segregated location for the privileged digital communications, but does not expressly state a “segregated server”.

Dickinson teaches *a segregated server housing the segregated location* (...) (see paras [0034-0038]); *wherein the program is further executable to send a copy of the communication to the segregated server* (see paras [0010], [0034-0038], and [0040-0041]), and a segregated location for privileged digital communications.



It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claims 41, Turnbull discloses:**

*A method for creating attorney-client privileged digital communication* (see Title and Abstract):

***creating an electronic communication*** (See abstract and columns 2-4 where a user creates an outgoing message)

***marking the electronic communication privileged with a privileged attribute which is selected by the creator of the electronic communication before the electronic communication is sent*** (See abstract and column 4, lines 7-30 where Turnbull discloses using attribute certificates which convey access privileges or authorization for certain actions set by a user).

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Turnbull does not expressly teach ***storing the electronic communication in a segregated location for privileged electronic communications on a data storage device.***

However, Liu discloses ***storing the privileged digital communication in a segregated location for privileged communications on a data storage device*** (See column 21, lines 6-20.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Turnbull with the teachings of Liu to store the communication at a segregated location specifically for privileged digital communications because both references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Turnbull discloses creating a distribution list of recipients and associating the list with a secure communication which meets the limitation, ***associating the privileged distribution list with the digital communication.*** See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

Turnbull and Liu do not teach *configuring access rights to the electronic communication.*

Dickinson teaches *configuring access rights to the electronic communication . . . when the electronic communication is created.* (see paras [0009], [0024] and [0030-0031]: The policy modules operate on confidential attachments to e-mails to require either encryption, signature, or both, in order to enforce attorney-client privileges);

Turnbull discloses the secure communications has associated access rights; however, Turnbull/Liu do not expressly teach ***enforcing said access rights by managing access to the electronic communication and controlling the manipulation of its contents based on the privileged distribution list; wherein the access rights include: forwarding of the communication; replying; and replying with copies to pre-selected recipients.***

However, Dickinson discloses configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents (see paragraphs [0009], [0024] and [0030-0031]).

Dickinson does not explicitly disclose forwarding of the communication.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to forward the communication for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing

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secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claims 45,** Turnbull teaches the secure communication is encrypted. See columns 3-5.

**Regarding claims 4 and 46,** Turnbull does not disclose sending a copy as a blind carbon copy; however, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include sending a copy as a blind carbon copy, a characteristic including a department of a corporation using the system, forwarding of the communication, and copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

**Regarding claims 5 and 47,** Turnbull/Liu does not disclose the segregated location for the privileged digital communication is divided by a common characteristic including a sender, a recipient, and a department of a corporation using the system.

However, Dickinson discloses a communication system (i.e. e-mail) containing a plurality of user specified information fields, such as source field specifying an e-mail address for the source of the message, a destination field specifying one or more destination e-mail addresses for the message, a subject field specifying a subject for the message, a body field specifying the body of the message containing textual and/or graphics data, and an optional attachment field, specifying one or more files to be transmitted with the message. Other user specified fields include, but are not limited to, priority of the message, identity of the sending agent, and the date and time of the message (see paragraph [0019]). Dickinson does not explicitly disclose a characteristic including a department of a corporation using the system. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a characteristic including a department of a corporation using the system, forwarding of the communication for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

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combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Claim 48** incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

**Regarding claims 6 and 50**, Turnbull discloses the secure communications has associated access rights; however, Turnbull/Liu do not expressly teach ***configuring access rights to the digital communication and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents.***

However, Dickinson discloses configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents (see paragraphs [0009], [0024] and [0030-0031]).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

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combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claim 7, 19, and 51,** Turnbull/Liu do not expressly teach different types of access rights; however, Dickinson discloses configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents (see paragraphs [0009], [0024] and [0030-0031]). Dickinson does not explicitly disclose forwarding of the communication. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to forward the communication for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claim 8, 20, 42, and 52,** Turnbull does not expressly teach the access rights including allowing copying and cutting the contents of the communication and pasting the cut out contents to another location. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

**Regarding claims 9, 21, and 54,** Turnbull discloses a privilege attribute associated with a communication but does not teach attaching the attribute to a communication according to predetermined selection criteria. Dickinson discloses executing automatically and attaching the privileged attribute or the executable module to particular communications according to predetermined selection criteria (see paragraphs [0022-0031].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the



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combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claims 10, 22, and 55,** Turnbull does not teach a confidentiality notice is displayed to the user and acknowledged before displaying the communication. However, Dickinson discloses a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e. notification actions).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claim 11,** Turnbull and Dickinson do not explicitly teach acknowledging a confidentiality notice by clicking on a GUI button. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include clicking on a GUI button for the motivational purpose acknowledging a pop-up window (*compare with* "confidentiality notice").

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claims 13 and 24,** Turnbull does not teach a server object and a client object. Dickinson discloses a server object and a client object (see paragraphs [0034-0037]). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Claims 14 and 15** incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

**Regarding claims 16 and 27**, Turnbull/Liu/Dickinson do not explicitly teach that the client object is a plug-in to a pre-existing communication system. However, Dickinson discloses the S/MIME protocol to exchange secure e-mail messages (see para [0034]). It is well known to a skilled artisan that most plug-in modules (e.g. Navigator) are based on MIME file types that simply plug in to the existing system.

Therefore, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a plug-in to a pre-existing communication system for the motivational purpose of adding a specific feature or service to a larger system. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claim 43**, Turnbull discloses a privilege attribute associated with a communication but does not teach attaching the attribute to a communication according to predetermined selection criteria. Dickinson discloses executing automatically and attaching the privileged attribute or the executable module to particular communications according to predetermined selection criteria (see paragraphs [0022-0031]).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**Regarding claims 44**, Turnbull does not teach a confidentiality notice is displayed to the user and acknowledged before displaying the communication. However, Dickinson discloses a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e. notification actions).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

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**Regarding claim 73**, Turnbull teaches sending a communication to a distribution list but does not expressly state the list is created from one recipient email address in a “To” text box although it was well known in the art at the time of the invention to place email addresses in the “To” text box. Dickinson teaches the email is entered into the “to” text box of a digital communication. See figure 2, “source”, element 205.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson’s segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**(10) Response to Argument**

**A. Rejections under 35 USC 103(a) over Turnbull et al. in view of Liu et al.**

**1. Claims 1, 2, 12, and 17**

On pages 8-12, Appellant argues the rejections for claim 1 over Turnbull in view of Liu. Appellant's arguments can be broken down into five main arguments as outlined below.

A) Appellant argues Liu does not teach storing a privileged digital communication (email) in a segregated location on a storage device. See page 9 of Brief. Appellant argues the section relied upon by the Examiner does not teach this feature because it teaches storing a private key and pre-computed data locally encrypted by a symmetric key derived from the signature phrase.

Examiner disagrees.

Examiner believes a segregated location is taught by Liu when he teaches storing the communication on the key server which facilitates secure transfers of messages. Specifically, the key server refers to a computer that includes a server program for maintaining, validating, and providing keys for use by clients in transmitting

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secure emails (i.e. privileged digital communications) and other messages over a network. See figure 1, figure 2B, 258 where a message is transmitted to a key server. See also column 3, lines 12-16, column 10, lines 31-36, and column 13, lines 3-11.

The instant Specification describes the "segregated location" on pages 14-15, paragraph [0053] which states, "The client object also transmits emails to the mail server with their corresponding privilege profiles, and performs encryption and decryption when necessary. **The server object maintains the privileged emails in a segregated location on the server's data storage device**, controls access to the privilege emails and manages encryption keys when encryption is used." Similarly, the key server of Liu discloses storing secure emails on the server and manages encryption keys when encryption is used. See figure 1, figure 2B, 258 where a message is transmitted to a key server. See also column 3, lines 12-16, column 10, lines 31-36, and column 13, lines 3-11

B) Appellant argues Turnbull does not teach "attach a privilege attribute to a digital communication, the privilege attribute selected by the creator of the digital communication before the digital communication is sent". Appellant argues there is no disclosure of digital communications in Turnbull and the privilege attribute is not selected by a creator of the digital communication. See page 10.

Examiner disagrees.

As an initial point, it is clear from Appellant's other arguments, that Appellant is cognizant of the fact that the Turnbull patent does in fact teach digital communications. For example, the second paragraph on page 10 indicates that Appellant knows Turnbull is drawn to "digital communications" or emails.

Turnbull discloses a system for extending secure communication operations. See abstract and title. Turnbull discloses using attribute certificates which convey access privileges or authorization for certain actions set by a user which meets the limitation, ***attach a privilege attribute to a digital communication, the privilege attribute selected by the creator of the digital communication before the digital communication is sent.*** See abstract and column 4, lines 7-30. See also column 5, lines 8-25. The issue the Appellant appears to be arguing is who attached the privilege attribute. Appellant never states how the privilege attribute is attached in Turnbull but states it is not by the creator. Examiner disagrees. Turnbull teaches that an administrator controls the security policy of the system indicated which users can create shared lists, modify shared lists, etc. However, Turnbull also teaches that any of the users (i.e. the end users) may be authorized to generate a shared list which includes the user identity and secure communication parameters which include encryption public key certificates, signature verification public key certificate, and other types of certificates. See column 5, lines 8-25 and 54-67 and column 6, lines 1-49 which discusses that an end user or creator of a secure communication can create a secure list and define the parameters such as key certificates.



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C) Appellant argues the references do not teach “creating a privileged distribution list of at least one intended recipient . . . when the digital communication is created”.

Appellant argues the shared lists disclosed in Turnbull are created before the creation of the secured communication. See pages 1-11.

Examiner disagrees.

As stated with respect to argument 2 above, Turnbull teaches any of the users can be authorized to generate a shared list which includes the user identity and secure communication parameters. This is created “when” the digital communication is created. Appellant emphasizes “when the digital communication is created”; however, clearly if a user sending a secure communication or email is defining the parameters and shared list of that communication, it is occurring as the communication is created.

D) Appellant argues the cited references do not teach “restricting access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list” and that the access described in Turnbull is regarding the “shared list” instead of the communication itself.

Examiner disagrees.

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Turnbull discloses the list of recipients is used to restrict access to the secure communication which meets the limitation, ***restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list***. See column 3, lines 14-51. In other words, if the digital communication is not allowed to be sent to a person who is not on the shared list, then clearly the access to the communication is restricted to those recipients in the list only. Thus, access to an email is limited to those people who are on the shared list only.

E) Appellant argues the references do not teach preventing the forwarding of digital communications to an unintended recipient.

Examiner disagrees.

Turnbull discloses a system to extend secure communication **operations** which include accessing and routing of secure communications. A user not on the list of intended recipients will not be able to receive the digital communication which meets the limitation, ***restrict routing of the privileged digital communication to the intended recipients and prevent forwarding of the digital communication to an unintended recipient***. See columns 3-4 and column 6, lines 28-49.

**2. Claim 18: Argued Separately.**

On pages 12-13, Appellant argues claim 18 for the same reasons set forth above with respect to claim 1. Accordingly, the remarks above also apply to claim 18.

Appellant further argues the cited references do not teach attaching an executable module to a digital communication when the communication is created. Claim 18 is drawn to the system for executing the method steps of claim 1 and was rejected under the same rationale used with respect to claim 1. With respect to an "executable module", Examiner refers Appellant to column 3, lines 52-column 4, lines 1-5 which discuss an executable module for performing the method steps of claim 1 above.

**3. Claims 23, 25 and 26**

On page 14, Appellant argues claim 22 is not included in the present rejection.

Examiner disagrees.

Examiner notes page 15 of this Examiner's Answer and page 14 of the final rejection addresses claim 22. Further, Appellant argues claim 22 again on page 25 of the Appeal Brief, indicating, that claim 22 was in fact rejected.

**4. Claims 49, 53, and 56**

On pages 14-15, Appellant argues independent claim 49 and claims 53 and 56 are allowable for the same reasons set forth with respect to claim 1. Accordingly, the remarks above with respect to claim 1 apply to claims 49, 53, and 56.

**5. Claims 57-59**

On pages 15-16, Appellant argues claims 57-59 are allowable for the same reasons set forth with respect to claims 1 and 18. Accordingly, the remarks above with respect to claims 1 and 18 apply to claims 57-59.

Appellant further argues the cited references do not teach an executable module which is attached to the privileged document by managing manipulation of its contents, according to a privileged distribution list created and associated with the digital document.

Examiner disagrees.

Turnbull teaches that only users listed in the shared list are authorized to receive and access secure communications which meets the limitation, ***managing manipulation of [its] contents, according to a privileged distribution list***. In other words, only authorized users could access or make changes to the contents of an email communication. This is done in order to enhance the security of an encrypted message as discussed on pages 1-2 of Turnbull.

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**6. Claim 71**

On page 17, Appellant argues claim 71 is allowable for the same reasons set forth with respect to claim 1. Accordingly, the remarks above with respect to claim 1 apply to claim 71.

**7. Claim 72: Argued Separately**

On pages 17-18, Appellant argues claim 72 is allowable for the same reasons set forth with respect to claims 1 and 18. Accordingly, the remarks above with respect to claims 1 and 18 apply to claim 72.

**B. Rejections under 35 USC 103 over Turnbull in view of Liu, and further in view of Dickinson**

On pages 19-20, Appellant argues claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 are not taught by the combination of references. Appellant argues Liu teaches away from the combination of Dickinson and Liu because Liu states firewalls are not desirable.

Examiner disagrees.

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

**1. Claims 3-9, 13-16, and 73**

On pages 20-21, Applicant makes the same arguments with respect to claims 3-9, 13-16, and 73 as he made with claim 1. Accordingly, the remarks above with respect to claim 1 also apply to claims 3-9, 13-16, and 73.

**2. Claims 10 and 11**

On pages 22-23, Appellant argues the cited references do not teach displaying a confidentiality notice to a user and acknowledged by a user before displaying the privileged communication as recited by claim 10.

Examiner disagrees.

However, Dickinson discloses a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e. notification actions). Notification actions cause the sending of one or more e-mail notifications when a given policy is triggered. Notifications can be sent to sender, recipient, administrator, or any e-mail address that is defined by the administrator. . . disposition action determines whether the message should continue to the destination(s) or whether one of a plurality of alternative actions 622 such as deferral, quarantine, return to sender, or dropping of the message are required.

With respect to claim 11, Appellant argues the Examiner makes a conclusory statement insufficient to establish obviousness.

Examiner disagrees.

Turnbull and Dickinson do not explicitly teach acknowledging a confidentiality notice by clicking on a GUI button. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include clicking on a GUI button for the motivational purpose acknowledging a pop-up window (*compare with* “confidentiality notice”). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson’s segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

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combination yielded nothing more than predictable results to one of ordinary skill in the art.

**3. Claims 19-21**

Appellant argues claims 19-21 are allowable for the same reasons discussed with respect to claim 18. Accordingly, the remarks above with respect to claim 18 also apply to claims 19-21.

**4. Claims 22, 24, and 27**

Appellant argues claim 22 is allowable for the same reasons stated with respect to claims 10 and 18 above. Accordingly, the remarks above with respect to claims 10 and 18 also apply to claims 22, 24, and 27.

**5. Claims 41-43 and 45-48**

Appellant argues claim 41 is allowable for the same reasons cited with respect to claim 1. Accordingly, the remarks made with respect to claim 1 also apply to claims 41-43 and 45-48.

Appellant further argues the cited references do not teach marking an electronic communication as privileged because Turnbull does not teach digital communications in any portions.



Examiner disagrees.

As an initial point, it is clear from Appellant's other arguments, that Appellant is cognizant of the fact that the Turnbull patent does in fact teach digital communications. For example, the second paragraph on page 10 indicates that Appellant knows Turnbull is drawn to "digital communications" or emails.

Turnbull discloses a system for extending secure communication operations. See abstract and title. Turnbull discloses using attribute certificates which convey access privileges or authorization for certain actions set by a user which meets the limitation, ***marking the electronic communication privileged with a privilege attribute which is selected by the creator of the digital communication before the digital communication is sent.*** See abstract and column 4, lines 7-30. See also column 5, lines 8-25. The issue the Appellant appears to be arguing is who attached the privilege attribute. Appellant never states how the privilege attribute is attached in Turnbull but states it is not by the creator. Examiner disagrees. Turnbull teaches that an administrator controls the security policy of the system indicated which users can create shared lists, modify shared lists, etc. However, Turnbull also teaches that any of the users (i.e. the end users) may be authorized to generate a shared list which includes the user identity and secure communication parameters which include encryption public key certificates, signature verification public key certificate, and other types of certificates. See column 5, lines 8-25 and 54-67 and column 6, lines 1-49 which discusses that an end user or creator of a secure communication can create a secure list and define the parameters such as key certificates.

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**6. Claim 44**

Appellant makes the same arguments with respect to claim 44 as he makes with claim 10. Accordingly, the remarks above with respect to claim 10 also apply to claim 44.

**7. Claims 50-52 and 54.**

Appellant argues claims 50-52 and 54 are allowable for the same reasons with respect to claim 49 above. Accordingly the remarks made with respect to claim 49 above also apply to claims 50-52 and 54.

**8. Claim 55**

Appellant makes the same arguments with respect to claim 55 as he makes with claim 10. Accordingly, the remarks above with respect to claim 10 also apply to claim 55.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Conferees:

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